UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,975	12/11/2000	Thomas Moran	476-1962	4647

23644 7590 01/23/2007

BARNES & THORNBURG LLP
P.O. BOX 2786
CHICAGO, IL 60690-2786

EXAMINER	
PATEL, ASHOKKUMAR B	
ART UNIT	**PAPER NUMBER**
2154	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/734,975	MORAN, THOMAS	
	Examiner	Art Unit	
	Ashok B. Patel	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 November 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) *18,19 and 32* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17 and 20-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *32* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-32 are subject to examination. Claims 18 and 19 are cancelled and claim 32 is subjected to restriction requirements

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-17 and 20-31 are drawn to a messaging system or method thereof wherein a messaging server arranged to store a plurality of pre-specified messages and an input to the communications network arranged to receive a information from user identifying a user selected one of the plurality of pre-specified messages and an indication of a destination party associated with said destination party mail box, and to communicate said information to the messaging server; wherein when the user information indicative of the destination party is received from said user at the messaging server, classified in class 709, subclasses 203.

II. Claim 32 is drawn to a messaging system for a telephony enabled communications network, and a telephony terminal arranged to receive a user input from user; and wherein when a specified user input is received from user at the telephony terminal, a user selected one of plurality of pre-specified messages is sent to the destination party mail box from the messaging server; and wherein the messaging system is configured such that no call needs to be set up between the terminal and the destination party mail box for

sending user selected one of said plurality of pre-specified messages to the destination party mail box.", classified in class 379, subclass 67.1.

III. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because telephony enabled communication network and a telephony terminal for receiving a specified user input to select one of plurality of pre-specified messages is sent to the destination party mail box from the messaging server; and wherein the messaging system is configured such that no call needs to be set up between the terminal and the destination party mail box for sending user selected one of said plurality of pre-specified messages to the destination party mail box is not required in combination I. The subcombination has separate utility such as a telephony terminal for receiving a specified user input to select one of plurality of pre-specified messages is sent to the destination party mail box from the messaging server; wherein the messaging system is configured such that no call needs to be set up between the terminal and the destination party mail box for sending user selected one of said plurality of pre-specified messages to the destination party mail box.

IV. These inventions are distinct for the reasons given above, and the search required for each Group is different and not co-extensive for examination purpose. For example, the searches for the two inventions would not be co-extensive because these groups would require different searches on PTO's classification class and subclass as following:

(a) Group I search would require use of search class 709, subclass 203.

(b) Group II search would require use of search class 379, subclass 67.1.

V. Newly submitted claim 32 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The claim is drawn to a messaging system for a telephony enabled communications network, and a telephony terminal arranged to receive a user input from user; and wherein when a specified user input is received from user at the telephony terminal, a user selected one of plurality of pre-specified messages is sent to the destination party mail box from the messaging server; and wherein the messaging system is configured such that no call needs to be set up between the terminal and the destination party mail box for sending user selected one of said plurality of pre-specified messages to the destination party mail box. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation

for prosecution on the merits. Accordingly, claim 32 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Examiner's note: Because there is no specific and explicit definition of "pre-specified message " is included in the claims, Examiner interprets this claim term according to the response dated 11/16/ 2005 provided by the Applicant, which is "The pre-specified message is made specific to the user by virtue of the fact that the user creates the message for storage on the messaging server by way of pre-recording the message at the user's mail box. Basis for this amendment is found at page 2, lines 19 to 21."

Response to Arguments

4. Applicant's arguments filed 03/30/2006 have been fully considered but they are not persuasive for the following reasons:

Applicant's argument:

"Applicant has generally amended the independent claims to a feature not disclosed nor suggested by Lung, namely to the feature that the sending of a pre-specified message to a destination party mail box is responsive to information from a user (the sender) identifying a selected one of a plurality of pre-specified messages stored at a messaging server that is to be sent to the destination party mail box and an indication of the identity of a destination party associated with the destination party mail box."

"There is no disclosure in Lung or any suggestion that a user can select any particular one of a plurality of such recorded messages for attachment to the email."

Examiner's response:

The following teachings of Lung address the response to these arguments.

Lung teaches at col. 7, line 32-44," Initially a user uses a telephone handset to dial a predetermined "attachment" feature code, step 600 preferably an extension number as will be explained below. Next, typically in response to a voice prompt, the user records a voice message (Note: This is a pre-specified message), step 610. In a preferred embodiment of the present invention, the system digitizes the voice message and places the recorded message in an "attachment" area (**a directory or file**), associated with the user, step 615. Then when the user sends an e-mail message to the system, the system determines whether there is a recorded message in the "attachment" area associated with the user, step 620. If so, the system forms a mixed-media message by combining the e-mail message and the recorded message, step 630."

Also, Lung clearly states at col. 8, line 13-14, "Memory storage 510 preferably stores these files into the "attachment" area specified by the user, step 615.

Lung further reveals at col. 8, line 53-62, "In alternative embodiments of the present invention, only one voice message attachment is provided, for example a PCM format message. In another embodiment of the present invention, **the voice message files** need not have been **created by the user**, the audio attachment file may be originally **created by another user**. For example, the **user may transfer** a voice-mail

message she previously received into her attachment area. In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment."

Thus, Lung's user's "attachment area" is "a directory" or "files" containing more than one messages. This provides a user with the selection of any one of the plurality of pre-specified messages to send to a destination party.

Thus, Lung provides the user "selection" from the pre-specified standard messages to be sent to the destination party mail box from the messaging server.

Applicant's argument:

"As such, it provides the user with an easy mechanism of communicating an appropriately selected one of a number of previously defined messages without having to place a call or make a communication directly with the destination party."

Examiner's response:

Examiner does not understand this argument as to how it is relevant to the claim limitation as claim limitation.

Applicant's argument:

The present invention as now claimed does not require the user to compose any form of message to which the selected pre-specified message must be attached for delivery."

Examiner's response:

Because there is no specific and explicit definition of "pre-specified message " is included in the claims, Examiner interprets this claim term according to the response

dated 11/16/ 2005 provided by the Applicant, which is "The pre-specified message is made specific to the user by virtue of the fact that the user creates the message for storage on the messaging server by way of pre-recording the message at the user's mail box. Basis for this amendment is found at page 2, lines 19 to 21."

Applicant's argument:

The system of Lung addresses a completely different need to that of the present application. Lung is directed at a document editing process whereby a user can attach verbal comments to a document message being conveyed to a recipient. Thus, the user uses a telephone handset to record his/her voice message which is placed in an attachment area together with any other recorded messages, possibly from other users, ready to be attached to an email being composed for sending to the recipient."

Examiner's response:

Lung teaches at col. 7, line 32-44," Initially a user uses a telephone handset to dial a predetermined "attachment" feature code, step 600 preferably an extension number as will be explained below. Next, typically in response to a voice prompt, the user records a voice message (Note: This is a pre-specified message), step 610. In a preferred embodiment of the present invention, the system digitizes the voice message and places the recorded message in an "attachment" area (**a directory or file**), associated with the user, step 615. Then when the user sends an e-mail message to the system, the system determines whether there is a recorded message in the "attachment" area associated with the user, step 620. If so, the system forms a mixed-

media message by combining the e-mail message and the recorded message, step 630."

Also, Lung clearly states at col. 8, line 13-14, "**Memory storage 510 preferably stores these files into the "attachment" area specified by the user**; step 615.

Lung further reveals at col. 8, line 53-62, "In alternative embodiments of the present invention, only one voice message attachment is provided, for example a PCM format message. In another embodiment of the present invention, **the voice message files** need not have been **created by the user**, the audio attachment file may be originally **created by another user**. For example, the **user may transfer** a voice-mail message she previously received **into her attachment area**. In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment."

Thus , "a user", not including "possibly from other users, has her own "attachment area" as specified by the user, in the memory storing messages as files, wherein the messages are created by the user as message files.

Applicant's argument:

"Furthermore, the process taught by Lung is a more user intensive process than that of the present invention in that it requires the user to use two different communication devices to create the mixed media message to be sent to a recipient and requires the user to compose a document message such as an email."

Examiner's response:

Examiner does not understand this argument as to how it is relevant to the claim limitation as claim limitation.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-17 and 20-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Lung et al. (hereinafter Lung)(US 6, 532, 230 B1).

Referring to claim 1,

Lung teaches a messaging system arranged to allow a user to send a pre-specified message to a destination party mail box (Fig. 4), said messaging system comprising a communications network comprising:-

a) a messaging server arranged to store a plurality of pre-specified messages (Fig. 4, element 535, Abstract, "A method for recording mixed-media messages using an integrated messaging server in response to a client application, the integrated messaging server including a processor coupled to a telephone switching server, to a storage, and to a message server, includes the steps of receiving a voice

message using a handset coupled with an analog line to the telephone switching server, storing the voice message in the storage, receiving a document from the client application using the message server, and associating the voice message with the document to form a mixed-media message.", col. 8, line 13-14, "Memory storage 510 preferably stores these files into the "attachment" area specified by the user"., col. 7, line 32-36,"Initially a user uses a telephone handset to dial a predetermined "attachment" feature code, step 600 preferably an extension number as will be explained below. Next, typically in response to a voice prompt, the user records a voice message, step 610.");

b) an input to the communications network arranged to receive a information from said user identifying a user selected one of the plurality of pre-specified messages (Lung teaches at col. 7, line 32-44," Initially a user uses a telephone handset to dial a predetermined "attachment" feature code, step 600 preferably an extension number as will be explained below. Next, typically in response to a voice prompt, the user records a voice message (Note: This is a pre-specified message), step 610. In a preferred embodiment of the present invention, the system digitizes the voice message and places the recorded message in an "attachment" area (**a directory or file**), associated with the user, step 615. Then when the user sends an e-mail message to the system, the system determines whether there is a recorded message in the "attachment" area associated with the user, step 620. If so, the system forms a mixed-media message by combining the e-mail message and the recorded message, step 630."

Also, Lung clearly states at col. 8, line 13-14, "Memory storage 510 preferably stores these files into the "attachment" area specified by the user, step 615.

Lung further reveals at col. 8, line 53-62, "In alternative embodiments of the present invention, only one voice message attachment is provided, for example a PCM format message. In another embodiment of the present invention, **the voice message files** need not have been **created by the user**, the audio attachment file may be originally **created by another user**. For example, the **user may transfer** a voice-mail message she previously received into her attachment area. In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment."

Thus, Lung's user's "attachment area" is "a directory" or "files" containing more than one messages. This provides a user with the selection of any one of the plurality of pre-specified messages to send to a destination party.

Thus, Lung provides the user "selection" from the pre-specified standard messages to be sent to the destination party mail box from the messaging server.) and an indication of a destination party associated with said destination party mail box, and to communicate said information to the messaging server (col. 8, line 53-62, "In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment.")

c) wherein when the user information indicative of the destination party is received from said user at the messaging server(col. 8, line 53-62, "In such a case, the user may then create an e-mail message with text having the voice-mail message as an

attachment.") , the user selected one of said plurality of pre-specified messages is sent to the destination party mail box from the messaging server (Lung further reveals at col. 8, line 53-62, "In alternative embodiments of the present invention, only one voice message attachment is provided, for example a PCM format message. In another embodiment of the present invention, **the voice message files** need not have been **created by the user**, the audio attachment file may be originally **created by another user**. For example, the **user may transfer** a voice-mail message she previously received into her attachment area. In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment.")

Referring to claim 2,

Lung teaches a messaging system as claimed in claim 1 wherein said input comprises a terminal connected to the communications network and comprising a user interface. (Fig. 4, element "DESKTOP COMPUTER", col. 6, line 30-32)

Referring to claim 3,

Lung teaches a messaging system as claimed in claim 2 wherein the terminal is connected to the messaging server via a communications network node being a private branch exchange. (Fig. 2, element "CO", col. 1, line 18-25, col. 5, line 33-46, Fig.11, col. 10, line 25-38).

Referring to claim 4,

Lung teaches a messaging system as claimed in claim 1 wherein the messaging server comprises a processor arranged to append information received from a user to

the user selected one of the plurality of the pre-specified messages. (Fig. 4, element 440, col. 7, line 1-12)

Referring to claim 5,

Lung teaches a messaging system as claimed in claim 1 wherein the messaging server comprises a processor arranged to append information received from a user to the user selected one of the plurality of pre-specified messages to create a combined message such that in use the messaging server is later able to separate the appended information from the combined message. (col. 7, line 32-44, Figs. 9 and 10)

Referring to claim 6,

Lung teaches a messaging system as claimed in claim 5 wherein the processor is arranged to create the combined message such that, in use, when the combined message is displayed to a user the appended information is displayed as part of the user selected one of the plurality of pre-specified message. (col. 7, line 32-44, Figs. 9 and 10)

Referring to claim 7,

Lung teaches a messaging system as claimed in claim 1, wherein the messaging server is a multimedia messaging server.(Fig.4, element 535)

Referring to claim 8,

Lung teaches a messaging system as claimed in claim 1 wherein the destination party mail box is located on a second messaging server. (Fig.11)

Referring to claim 9,

Lung teaches a messaging system as claimed in claim 3 wherein the communications network node is arranged to route the additional information to the messaging server together with one or more control signals that are arranged to indicate that the additional information is to be appended to a user selected one of the plurality of pre-specified message. (col. 8, line 53-62)

Referring to claim 10,

Lung teaches a messaging system as claimed in claim 1 wherein the plurality of pre-specified messages are stored in a mail box on the messaging server, said mail box being associated with the user. (Fig.11)

Referring to claim 11,

Lung teaches a method of sending a pre-specified message, from a user to a destination party mail box in a communications network (Fig. 4), said method comprising the steps of:-

(i) storing a plurality of pre-specified messages at a messaging server in the communications network (Fig.4, element 535, col. 7, line 32-36);

(ii) receiving information from said user, said information indicating that a user selected one of the plurality of pre-specified messages is to be sent to the destination party mail box (Lung teaches at col. 7, line 32-44," Initially a user uses a telephone handset to dial a predetermined "attachment" feature code, step 600 preferably an extension number as will be explained below. Next, typically in response to a voice prompt, the user records a voice message (Note: This is a pre-specified message), step 610. In a preferred embodiment of the present invention, the system digitizes the

voice message and places the recorded message in an "attachment" area (**a directory or file**), associated with the user, step 615. Then when the user sends an e-mail message to the system, the system determines whether there is a recorded message in the "attachment" area associated with the user, step 620. If so, the system forms a mixed-media message by combining the e-mail message and the recorded message, step 630."

Also, Lung clearly states at col. 8, line 13-14, "Memory storage 510 preferably stores these files into the "attachment" area specified by the user, step 615.

Lung further reveals at col. 8, line 53-62, "In alternative embodiments of the present invention, only one voice message attachment is provided, for example a PCM format message. In another embodiment of the present invention, **the voice message files** need not have been **created by the user**, the audio attachment file may be originally **created by another user**. For example, the **user may transfer** a voice-mail message she previously received into her attachment area. In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment."

Thus, Lung's user's "attachment area" is "a directory" or "files" containing more than one messages. This provides a user with the selection of any one of the plurality of pre-specified messages to send to a destination party.

Thus, Lung provides the user "selection" from the pre-specified standard messages to be sent to the destination party mail box from the messaging server.), said information indicative of a destination party associated with said destination party mail

box, and communicating said information to the messaging server (col. 8, line 53-62, "In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment."); and

(iii) in response to the user information indicative of the destination party being received at the messaging server sending the user selected one of the plurality of pre-specified messages from the messaging server to the destination party mail box. (col. 8, line 53-62, "In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment.", Lung further reveals at col. 8, line 53-62, "In alternative embodiments of the present invention, only one voice message attachment is provided, for example a PCM format message. In another embodiment of the present invention, **the voice message files** need not have been **created by the user**, the audio attachment file may be originally **created by another user**. For example, the **user may transfer** a voice-mail message she previously received into her attachment area. In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment.")

Referring to claim 12,

Lung teaches a method as claimed in claim 11 wherein the input is received via a terminal. (Fig. 4, element "DESKTOP COMPUTER", col. 6, line 30-32)

Referring to claim 13,

Lung teaches a method as claimed in claim 12 which further comprises setting up a call between the terminal and the messaging server and receiving information from

the user via this call, to be appended to the selected one of the plurality of pre-specified messages.(col. 9, line 49-52)

Referring to claim 14,

Lung teaches a method as claimed in claim 13 wherein the call is routed via a communications network node between the terminal and the messaging server and wherein that communications network node is arranged to send a control signal to the messaging server, indicating that the received information is to be appended to the user selected one of the plurality of pre-specified messages. .(col. 9, line 49-52, Fig. 4, Fig.11, (Fig. 2, element "CO", col. 1, line 18-25, col. 5, line 33-46, Fig.11, col. 10, line 25-38)

Referring to claims 15,

Lung teaches a messaging server for sending a pre-specified message, from a user to a destination party mail box in a communications network (Fig. 4, element 408, and Fig. 11), said messaging server comprising:

(i) a store containing a plurality of pre-specified message (Fig. 4, element 510);

(ii) an input arranged to receive information from said user, said information indicating that a user selected one of the plurality of pre-specified messages is to be sent to the destination party mail box (Lung teaches at col. 7, line 32-44," Initially a user uses a telephone handset to dial a predetermined "attachment" feature code, step 600 preferably an extension number as will be explained below. Next, typically in response to a voice prompt, the user records a voice message (Note: This is a pre-

specified message), step 610. In a preferred embodiment of the present invention, the system digitizes the voice message and places the recorded message in an "attachment" area (**a directory or file**), associated with the user, step 615. Then when the user sends an e-mail message to the system, the system determines whether there is a recorded message in the "attachment" area associated with the user, step 620. If so, the system forms a mixed-media message by combining the e-mail message and the recorded message, step 630."

Also, Lung clearly states at col. 8, line 13-14, "Memory storage 510 preferably stores these files into the "attachment" area specified by the user, step 615.

Lung further reveals at col. 8, line 53-62, "In alternative embodiments of the present invention, only one voice message attachment is provided, for example a PCM format message. In another embodiment of the present invention, **the voice message files** need not have been **created by the user**, the audio attachment file may be originally **created by another user**. For example, the **user may transfer** a voice-mail message she previously received into her attachment area. In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment."

Thus, Lung's user's "attachment area" is "a directory" or "files" containing more than one messages. This provides a user with the selection of any one of the plurality of pre-specified messages to send to a destination party.

Thus, Lung provides the user "selection" from the pre-specified standard messages to be sent to the destination party mail box from the messaging server.), said

information indicative of a destination party associated with the destination party mail box, and to communicate said information to the messaging server; (col. 8, line 53-62, "In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment.")

(iii) a processor arranged to send the user selected one of the plurality of pre-specified messages to the destination party mail box in response to receipt of said user information indicative of the destination party. (col. 8, line 53-62, "In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment.", Lung further reveals at col. 8, line 53-62, "In alternative embodiments of the present invention, only one voice message attachment is provided, for example a PCM format message. In another embodiment of the present invention, **the voice message files** need not have been **created by the user**, the audio attachment file may be originally **created by another user**. For example, the **user may transfer** a voice-mail message she previously received into her attachment area. In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment.")

Referring to claim 16,

Lung teaches a communications network comprising a destination party mail box and a messaging server for sending a pre-specified message, from said user to the destination party mail box (Figs. 4 and 11), said messaging server (Fig.4, element 408) comprising:

(i) a store containing a plurality of pre-specified messages (Fig. 4, element 510);

(ii) an input arranged to receive information from said user, said information indicating that a user selected one of the plurality of pre-specified messages is to be sent to the destination party mail box (Lung teaches at col. 7, line 32-44," Initially a user uses a telephone handset to dial a predetermined "attachment" feature code, step 600 preferably an extension number as will be explained below. Next, typically in response to a voice prompt, the user records a voice message (Note: This is a pre-specified message), step 610. In a preferred embodiment of the present invention, the system digitizes the voice message and places the recorded message in an "attachment" area (**a directory or file**), associated with the user, step 615. Then when the user sends an e-mail message to the system, the system determines whether there is a recorded message in the "attachment" area associated with the user, step 620. If so, the system forms a mixed-media message by combining the e-mail message and the recorded message, step 630."

Also, Lung clearly states at col. 8, line 13-14, "Memory storage 510 preferably stores these files into the "attachment" area specified by the user, step 615.

Lung further reveals at col. 8, line 53-62, "In alternative embodiments of the present invention, only one voice message attachment is provided, for example a PCM format message. In another embodiment of the present invention, **the voice message files** need not have been **created by the user**, the audio attachment file may be originally **created by another user**. For example, the **user may transfer** a voice-mail

message she previously received into her attachment area. In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment."

Thus, Lung's user's "attachment area" is "a directory" or "files" containing more than one messages. This provides a user with the selection of any one of the plurality of pre-specified messages to send to a destination party.

Thus, Lung provides the user "selection" from the pre-specified standard messages to be sent to the destination party mail box from the messaging server.), said information indicative of a destination party associated with the destination party mail box, and to communicate said information to the messaging server (col. 8, line 53-62, "In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment."); and

(iii) a processor arranged to send the user selected one of the plurality of pre-specified messages to the destination party mail box in response to receipt of said user information indicative of the destination party. (col. 8, line 53-62, "In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment.", Lung further reveals at col. 8, line 53-62, "In alternative embodiments of the present invention, only one voice message attachment is provided, for example a PCM format message. In another embodiment of the present invention, **the voice message files** need not have been **created by the user**, the audio attachment file may be originally **created by another user**. For example, the **user may transfer** a voice-mail message she previously received into her attachment area. In such a case, the

user may then create an e-mail message with text having the voice-mail message as an attachment.")

Referring to claim 17,

Claim 17 is a claim to a computer program that carries out the method steps of claim 15. Therefore, claim 17 is rejected for the reasons set forth for the claim 15.

Referring to claim 20,

Lung teaches a messaging system arranged to allow a user to send a pre-specified message to a destination party mail box(Fig. 4),, said messaging system comprising a communications network comprising:

a) a messaging server arranged to store a plurality of pre-specified messages (Fig. 4, element 535, Abstract, "A method for recording mixed-media messages using an integrated messaging server in response to a client application, the integrated messaging server including a processor coupled to a telephone switching server, to a storage, and to a message server, includes the steps of receiving a voice message using a handset coupled with an analog line to the telephone switching server, storing the voice message in the storage, receiving a document from the client application using the message server, and associating the voice message with the document to form a mixed-media message.", col. 8, line 13-14, "Memory storage 510 preferably stores these files into the "attachment" area specified by the user"., col. 7, line 32-36,"Initially a user uses a telephone handset to dial a predetermined "attachment" feature code, step 600 preferably an extension number as will be explained below.

Next, typically in response to a voice prompt, the user records a voice message, step 610.");

b) an input to the communications network arranged to receive information from said user, said information indicating that a user selected one of the plurality of pre-specified messages is to be sent to the destination party mail box (Lung teaches at col. 7, line 32-44," Initially a user uses a telephone handset to dial a predetermined "attachment" feature code, step 600 preferably an extension number as will be explained below. Next, typically in response to a voice prompt, the user records a voice message (Note: This is a pre-specified message), step 610. In a preferred embodiment of the present invention, the system digitizes the voice message and places the recorded message in an "attachment" area (**a directory or file**), associated with the user, step 615. Then when the user sends an e-mail message to the system, the system determines whether there is a recorded message in the "attachment" area associated with the user, step 620. If so, the system forms a mixed-media message by combining the e-mail message and the recorded message, step 630."

Also, Lung clearly states at col. 8, line 13-14, "Memory storage 510 preferably stores these files into the "attachment" area specified by the user, step 615.

Lung further reveals at col. 8, line 53-62, "In alternative embodiments of the present invention, only one voice message attachment is provided, for example a PCM format message. In another embodiment of the present invention, **the voice message files** need not have been **created by the user**, the audio attachment file may be originally **created by another user**. For example, the **user may transfer** a voice-mail

message she previously received into her attachment area. In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment."

Thus, Lung's user's "attachment area" is "a directory" or "files" containing more than one messages. This provides a user with the selection of any one of the plurality of pre-specified messages to send to a destination party.

Thus, Lung provides the user "selection" from the pre-specified standard messages to be sent to the destination party mail box from the messaging server.),said information indicative of a destination party associated with the destination party mail box, and to communicate said information to the messaging server(col. 8, line 53-62, "In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment."); and

c) wherein when the user information indicative of the destination party is received from said user at the messaging server, the user selected one of said plurality of pre-specified messages is sent to the destination party mail box from the messaging server (col. 8, line 53-62, "In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment.", Lung further reveals at col. 8, line 53-62, "In alternative embodiments of the present invention, only one voice message attachment is provided, for example a PCM format message. In another embodiment of the present invention, **the voice message files** need not have been **created by the user**, the audio attachment file may be originally **created by another user**. For example, the **user may transfer** a voice-mail message she previously

received into her attachment area. In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment.");

wherein the messaging system further comprises a processor arranged to append spoken information received from the user to the pre-specified message prior to it being sent to the destination party mail box. (Fig.5, col. 10, line 49-52," An e-mail message may also be text alone, text and an image, an image alone, a presentation with images, text and audio narration or accompaniment, or any other data converted for transmittal via an electronic mail system.")

Referring to claim 21,

Lung teaches a messaging system as claimed in claim 20 wherein said input comprises a user terminal connected to the communications network and comprising a user interface. (Fig. 4, element "DESKTOP COMPUTER", col. 6, line 30-32)

Referring to claim 22,

Lung teaches a messaging system a: claimed in claim 21 wherein, in response to a user input, said processor is arranged to establish a call between the user terminal and the messaging system to receive from said user the spoken information to be appended to the user selected one of said plurality of pre-specified messages. (.col. 9, line 49-52)

Referring to claim 23,

Lung teaches a messaging system as claimed in claim 20 wherein the processor is arranged to append the spoken information received from the user to the user selected one of said plurality of pre- specified messages to create a combined message such

that the messaging server is later able to separate the appended spoken information from the combined message. (col. 9, line 49-52, col. 7, line 32-44, Figs. 9 and 10)

Referring to claim 24,

Lung teaches a messaging system as claimed in claim 20 wherein the plurality of pre-specified messages are stored in a mail box on the messaging server, said mail box being associated with the user.((Fig.11)

Referring to claim 25,

Claim 25 is a claim to a method of sending a pre-specified message from a user to a destination party mail box in a communications network incorporated by the system of 20. Therefore claim 25 is rejected for the reasons set forth for claim 20.

Referring to claim 26,

Claim 26 is a claim to a method of sending a pre-specified message from a user to a destination party mail box in a communications network incorporated by the system of 21. Therefore claim 26 is rejected for the reasons set forth for claim 21.

Referring to claim 27,

Claim 27 is a claim to a method of sending a pre-specified message from a user to a destination party mail box in a communications network incorporated by the system of 22. Therefore claim 27 is rejected for the reasons set forth for claim 22.

Referring to claim 28,

Claim 28 is a claim to a method of sending a pre-specified message from a user to a destination party mail box in a communications network incorporated by the system of 23. Therefore claim 28 is rejected for the reasons set forth for claim 23.

Referring to claim 29,

Claim 29 is a claim to a messaging server that carries out the method of claim 25. Therefore claim 29 is rejected for the reasons set forth for claim 25.

Referring to claim 30,

Claim 30 is a claim to communications network incorporating the system of claim 20. Therefore claim 30 is rejected for the reasons set forth for claim 20.

Referring to claim 31,

Claim 31 is a claim to computer program stored on a computer readable medium, said computer program being for controlling a messaging server of claim 29. Therefore claim 31 is rejected for the reasons set forth for claim 29.

Prior Art not relied upon:

Please refer to the reference Berthoud et al. (US 7, 054, 428) listed in the attached PT0-892 which are not relied upon for claim rejections since these references are relevant to the claimed invention.

Berthoud et al. teaches at col. 3, line 28-col. 4, line 50, "Given the scenario depicted in FIG. 2, the caller at telephone 32 would conventionally be provided with a busy signal when attempting to call the Internet user's telephone 12. However, in accordance with the principles of the present invention, the caller 32 is provided with an ability to notify the Internet user of their attempted telephone call through the Internet. Moreover, in one embodiment, the appropriate central office in the PSTN 22 can detect the presence of data communications on the telephone line 107 attempted to be called, and audibly notify the caller at telephone 32 with a canned message. The central office may be provided with sufficient information to, upon request by the caller, call the called party's ISP 109 and request that an appropriate notification message be sent to the Internet user's user interface device, e.g., display 18.

To receive and act on such request for an appropriate notification message to be sent to a particular subscriber to the ISP 109, the ISP 109 includes an Internet communication module 28, and a textual or audible message recorder/IP formatter 30.

The Internet communication module 28 receives requests for notification messages from would-be callers (or an appropriate central office), and prompts the

caller for input relating to the identity of the Internet user. For instance, upon receipt of a telephone call from the would-be caller to send the notification message, the Internet communication module 28 causes an audible prompt for a unique identifying number of the Internet user, which the caller inputs using the keypad of their telephone 32. Appropriate identifying numbers include a telephone number of the Internet user, or a personal identity number (PIN) specifically assigned to the Internet user. Alphanumeric identifying numbers are possible, but limited to the uniqueness provided by the standard 12-key touch tone keypad.

Upon identification of the appropriate Internet user to the Internet communication module 28 at the ISP 109, the caller may be provided with the opportunity to select from a plurality of possible notification messages, e.g., using keypad input. Alternatively, a standard notification message can be formed using call related information regarding the caller (e.g., Caller ID type information such as telephone number and/or household or business name) and sent as a text message to the Internet user.

The notification message may be a text message and/or an appropriately digitized audible message, e.g., in the form of a ".wav" file. The notification message may be communicated to the Internet user using conventional forms of communication, e.g., using e-mail, or may be communicated to the Internet user via a localized communication means, e.g., using a chat room provided by a particular ISP 109. When using e-mail, a textual notification message may be contained in the body of the e-mail, and/or a file containing a digitized notification message may be attached to the e-mail for playback using an appropriate application already resident on the Internet user's computer 14.

The selected notification message is appropriately formatted by the textual or audible message recorder/IP formatter module 30. The formatter module 30 may include a plurality of pre-recorded audible and/or textual notification messages for the caller to choose from, or may allow the caller to record and digitize a personalized audible message.

The formatter module 30 also formats the selected notification message into an appropriate form for the ISP's particular mode of communication. For instance, if e-mail is the form of communication used by the particular ISP, then the formatter module 30 formats an appropriate e-mail message together with an attached ".wav" or other digitized audio file if necessary, and sends it to the appropriate e-mail address on file for the particular Internet user.

The e-mail address may be maintained in an appropriate table for access by the formatter module 30.

In operation, a caller using the telephone 32 may unsuccessfully attempt to call the telephone 12 of the Internet user. Either knowing the propensity of the attempted called party, or after being informed of likely Internet usage by the central office by the called Internet user, the caller can hang up, and then place another telephone call to a specially designated, predetermined telephone number (e.g., in a modem bank 26) at the ISP 109. Upon appropriate prompting initiated by the Internet communication module 28, the caller at telephone 32 would input a unique identifying number for the Internet user, e.g., a telephone number used in this case as a special designate for the

Internet user. The caller may also be provided with the opportunity to select or record a particular notification message.

In response, the formatter module 30 selects and formats the appropriate notification message, and sends it to the Internet user over the data communication line established between the Internet user and the ISP 109.

Conclusion

Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok B. Patel whose telephone number is (571) 272-3972. The examiner can normally be reached on 6:30 am-4:30 pm.

NATHAN J. FLYNN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan A. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Abp
